

**REMARKS**

Claims 1, 3-23, 25-36, 38-46, 48-54, 56-71, and 73-96 are now pending and stand rejected. Applicant is submitting a Request for Continued Consideration (RCE) with this Preliminary Amendment. By this Preliminary Amendment, Applicant has amended the claims and demonstrates reasons why the claims pending here are distinct from the asserted art. In particular, the Examiner has amended independent claim 1. In view of the amendments and the arguments below, Applicant respectfully requests the Examiner to reconsider all the outstanding rejections and to withdraw them.

***35 U.S.C. § 112 Rejections***

In paragraphs 2 and 3 of the office action, the Examiner has rejected claims 1 and 3-22 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner indicates that the claims contain “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.” Specifically, in paragraph 3 of the office action, the Examiner points out that, with respect to claim 1, Applicants “wrote an instruction not to send the electronic data if the electronic data does not have a supported format.” The Examiner has indicated that he “cannot find any support for this limitation.” The Examiner considers the “not” as a negative limitation, and cites the MPEP in support of the rule requiring that any “negative limitation or exclusionary proviso must have basis in the original disclosure.” Applicants point to the various exemplary locations in the specification below that support the claimed recitation.

Specification	Specification Location
When such an application is loaded on the electronic device, the information is said to have a supported format.	Page 3, para. [0004], lns. 4-5
If unsupported information is sent	Page 3, para. [0005], ln. 5
...prevent a particular type of information from being transmitted.	Page 4, lns. 1-2

Specification	Specification Location
Regardless of whether desired information is supported by applications on the electronic device, a user may wish to prevent information from certain source locations from being transmitted to the device.	Page 4, para. [0008], lns. 1-4
Thus, while preventing unusable information from being transmitted to the device may be desirable, it may also be desirable to prevent particular usable information from being transmitted.	Page 4, para. [0008], lns. 7-9
Thus, there is a need to provide a method for transmitting electronic information over a wireless connection to a portable electronic device while excluding unsupported data and information.	Page 4, para. [0009], lns. 1-3
There is still a further need to provide a method for preventing the transmission of information from certain source locations, regardless of whether information is supported by applications included in the device. There is still yet a further need for automatically preventing unsupported or undesired information from being transmitted over a wireless connection to an electronic device.	Page 5, lns. 2-7
The method further includes automatically issuing a transfer instruction for the electronic data based on acceptability criteria, where the acceptability criteria comprises whether the electronic data has a supported format.	Page 5, para [0011], lns. 5-8
The method also includes filtering the requested information to exclude incompatible information and wirelessly transmitting the filtered information to the electronic device.	Page 5, last line to Page 6, lns. 1-2
The method further includes comparing the format of the data to a list of data formats supported by an electronic device and transmitting to the electronic device only portions of the data having a supported data format.	Page 6, para. [0014], lns. 6-9

Specification	Specification Location
The method also includes comparing within the data transmission system the format of the requested data to the list of supported data formats and wirelessly transmitting the requested data to the portable electronic device only if it has a supported format.	Page 6, para [0015], lns. 7-8 to page 7, lns. 1-2
The system also includes means for filtering the electronic data to transmit only compatible electronic data.	Page 7, para [0017], lns. 8-9
The system also includes means for transferring the electronic information from a remote location to the proxy server, means for comparing the electronic information to the list of supported file types, and means for wirelessly transmitting electronic information to the electronic device only if the electronic information has a supported file type.	Page 7, para. [0018], last line, to page 8, lns. 1-5
In an exemplary embodiment, only requested information having a supported data format will be forwarded to electronic device 100.	Page 12, para. [0035], lns. 1-2
If, on the other hand, information 142 has either an unsupported format or an unacceptable source location, the transfer instruction will comprise an instruction not to send information 142 to electronic device 100. In an alternative embodiment, only the list of supported data formats 150 will be used by proxy server 132, and the only acceptability criterion may be whether information 142 has a supported format. In this alternative embodiment, the source location of the information 142 is not relevant to the transfer instruction, and only where information 142 has a supported format will it be wirelessly transmitted to electronic device 100.	Page 17, para. [0045], lns. 11-15 to page 18, lns. 1-5

Nonetheless, the claim 1 is amended to eliminate the negative recitation, even though Applicants have demonstrated above that it is supported by the specification. Claims 3-22

depend either directly or indirectly on claim 1. The Examiner is respectfully requested to withdraw his 112 rejection of claim 1 as well as claims 3-22 for the reasons urged here.

### **35 U.S.C. § 103 Rejections**

In paragraph 6 of the office action, the Examiner has variously rejected the claims 1, 3, 7-19, 23, 25, 29-30, 32-33, 35, 38, 41-44, 46, 48, 51, 53, 56-59, 67-69, 71, 78-80, 86, 88-89, and 94-94 under 35 U.S.C. § 103(a) as being unpatentable over a primary reference, Janakiraman et al. (U.S. Patent Application Publication No. 2002/0124020), in view of a second reference, Nelson et al. (U.S. Patent No. 6,498,897), and further in view of a third reference, Castell et al. (U.S. Patent Application Publication No. 2002/0132607).

Applicants respectfully traverse that it would have been obvious to combine the references as the Examiner suggests and urges the Examiner to reconsider the rejections in view of the following reasoning set forth below.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)).

With respect to claims 1, 23, 35, 46, 53, 67 and 86, the Examiner simply states that Janakiraman teaches all the claimed limitations and is silent on “sending a list of supported formats to a proxy server.” The Examiner suggests curing this deficiency by introducing Nelson, for its teaching in a wireless communication method, of “sending a list of supported formats [col.4, lns.23-26 i.e. MPEG-1, MPEG-2, MPEG-4, H.263, Realvideo, and other packetized

forms of digital media] to a proxy server [item 44 of fig.51 [figs.2-41].” Moreover, the Examiner indicates the following:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Janakiraman in view of Nelson by sending a list of supported formats to a proxy server because this feature enables to select the appropriate format and applications for playback based upon the specific characteristics [Nelson, col.2, lns.46-52]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Janakiraman in view of Nelson in order to properly initialize the decoder for the media format [Nelson, col.1, lns.24-25].

However, the Examiner does not indicate the motivation in the primary reference that invites a combination with the secondary reference Nelson, much less the third reference Castell. The Examiner relies on the third reference Castell for its suggestion of “the transfer instruction” including “an instruction to send the electronic data if the electronic data has a supported format, and wherein the transfer function includes an instruction not to send the electronic data if the electronic data does not have a supported format.”

Further, Applicants respectfully submit that obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of

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each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In paragraphs 8-45, the Examiner has variously rejected dependent claims and independent claims 61 and 81 over two or more references. Applicants respectfully submit that there is no motivation in any of the references to combine them as the Examiner suggests. Moreover, the claims are amended to further define that the claimed transmission of data occurs over a wireless connection. Applicants respectfully request the Examiner reconsider his rejections based on the legal reasoning and case law cited here as well as the amendments to the independent claims. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

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